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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDDIE M. SCHWALB

Appeal 2008-0848
Application 09/924,136[1]
Technology Center 2100

Decided: October 9, 2008

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 8 through 14, 16, and 20 through 29. Claims 1 through 7,

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[1] Filed on Aug. 07, 2001. The real party in interest is Sharp Laboratories of America, Inc.

15, and 17 through 19 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellant invented a method and system that uses a declarative application programming interface (API) to access services within a Digital TV Application Software Environment (DASE). (Spec. 2.) Particularly, as depicted in Figures 1 and 2, the invention uses an XDML API module (12) to access Program System Information Protocol (PSIP) data (26). (Spec. 4, 9-10.) The XDML application program introduces new tags having semantics to enable HTML pages to perform an active dynamic discovery of one of the services within the DASE. (*Id.*)

Independent claim 8 further illustrates the invention. It reads as follows:

8. A method of providing access to one or more services within a Digital TV Application Software Environment (DASE), the method comprising:

receiving a transport stream having content and one or more applications, wherein the one or more applications provide the one or more services within the Digital TV Application Software Environment (DASE);

using a renderer to interpret and prepare the content for rendering on a display device;

mapping at least one XDML document to a Document Object Model (DOM) structure, the XDML document having at least one atomic element defined as a "tag" and the DOM having an atomic element defined as a "node;" and

using a declarative application program interface to access Program System Information Protocol (PSIP) data, wherein the declarative application program interface comprises an XDML application program interface module that introduces new tags having semantics that enable HTML pages to perform an active dynamic discovery of at least one of (i) the content and (ii) the services, wherein the XDML application program interface module includes a rule structure for:

defining a condition within the node;

upon satisfaction of the condition, realizing an action defined by the at least one tag, which action is found within the PSIP data; and

otherwise, realizing an action defined by the node.

The Examiner relies on the following prior art as evidence of unpatentability:

Eyer	US 5,982,445	Nov. 9, 1999
Burkett	US 6,635,089 B1	Oct. 21, 2003 (filed Jan. 13, 1999)

Ted Wugofski, *A Modular Hypertext Markup Language for Broadcast Applications,* Over the Moon Productions / Gateway, Draft #4 (1998), available at http://xml.coverpages.org/bhtml-4.html.

Advanced Television Systems Committee ("A90"), *ATSC Data Broadcast Standard (Including Amendment 1 and Corrigendum 1 and Corrigendum 2)*, (2000).

Michael A. Dolan, *Report on Television Data Applications,* NIST GCR 01-818, Technology Administration, U.S. Department of Commerce (2001).

The Examiner rejects the claims on appeal as follows:

A. Claims 8 through 10, 12, 13, and 23 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wugofski, A90, and Dolan.

B. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wugofski, A90, Dolan, and Burkett.

C. Claims 14, 16, 20 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wugofski, A90, Dolan, and Eyer.

PRINCIPLES OF LAW

OBVIOUSNESS

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. at 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

ANALYSIS

Independent claims 8, 14, and 24 recite in relevant part using an XDML API to access PSIP data within a DASE to thereby perform an active dynamic discovery of one of the services within the DTV. (Claims Appendix.)

Appellant argues that the Examiner has not shown that the combined disclosures of Wugofski, A90, and Dolan teach these recitations. (App. Br. 14-21, Reply Br. 7-9.) Particularly, Appellant argues that the suggested combination teaches at best using an XDML application to access data in a DASE. However, Appellant argues that the Examiner has not shown that the XDML application resulting from the suggested combination can be used to access PSIP data and to perform the dynamic active discovery. (*Id.*)

In response, the Examiner avers that the combination of Wugofski, A90, and Dolan teaches the claimed recitations. (Ans. 4-6.) Particularly, the Examiner finds that Wugofski's disclosure of using an XHTML application to access data in a DASE teaches the declarative API. (Ans. 10.) Further, the Examiner finds that Dolan teaches using XDML that provides a program guide. (*Id.* 11-12). Additionally, the Examiner finds that A90 discloses accessing PSIP data. (*Id.*) Thus, the Examiner concludes that the suggested combination renders the claimed invention unpatentable. (*Id.*)

Thus, the pivotal issue before us is whether one of ordinary skill in the art would have found that the combined disclosures of Wugofski, A90, and Dolan teach or suggest using an XDML API that accesses PSIP data within a DASE to thereby perform an active dynamic discovery of one of the services within the DTV, as recited in independent claims 8, 14, and 24. We answer this inquiry in the negative.

We do not sustain the rejection of claims 8 through 14, 16, and 20 through 29 substantially for the reasons set forth in Appellant's briefs. We find Appellant's arguments to be persuasive, and to have consequently shown error in the Examiner's prima facie case of obviousness.

The Examiner's statements of rejection and response to arguments point to different elements of Wugofski, Dolan, and A90 that are deemed to correspond to some of the terms recited in the claims. However, they do not account for all the limitations as they are set out, and interrelated, in the claims. Particularly, the Examiner relies upon sections 9.2 and 9.3 of Dolan

for allegedly teaching using declarative systems to provide program guides. (Ans. 11-12.) We do not agree with the Examiner. As correctly pointed out by Appellant, while the recited sections appear to suggest the use of declarative applications to access certain services in a DASE, such services do not include electronic programming guides. Similarly, we find the Examiner's reliance on A90 to be misplaced. While the relevant portion of A90 teaches that PSIP data includes program guide data, it does not teach an XDML API can be used to access the programming guide data. Additionally, we find the Examiner's reliance upon appendix AG.3 of Wugofski (Ans. 13) as suggesting a specific behavior in response a PSIP event starting or ending to be insufficient to cure the noted deficiencies. As correctly pointed out by Appellant (App. Br. 18-19), the ordinarily skilled artisan would readily appreciate that recognizing the start or end of a PSIP event does not particularly suggest accessing the PSIP data itself.

Lastly, the Examiner reproduces in part the text of section 4.2 of Wugofski for allegedly teaching an XDML API that performs an active dynamic discovery of at least one of the services within the DTV. (Ans. 13.) Beyond that mere citation, the Examiner has not otherwise provided any further explanation to substantiate the alleged equivalency between the claimed recitation and the cited text. We are at a loss to understanding how the cited text teaches the claimed recitation.

To somehow conclude that the sections of Wugofski, Dolan, and A90 upon which the Examiner relies teach the claimed recitations set forth above

would require for us to resort to speculations. Further, we agree with Appellant that neither Burkett nor Eyer cures the noted deficiencies of the cited combination. It follows that on the record before us Appellant has shown that the Examiner erred in concluding that Wugofski, Dolan, and A90, taken alone or in combination with Eyer or Burkett, renders independent claims 8, 14, and 24, as well as their respective dependent claims unpatentable.

CONCLUSIONS OF LAW

On the record before us, Appellant has shown that the Examiner erred in concluding that:

1. The combination of Wugofski, Dolan, and A90 renders claims 8 through 10, 12, 13, and 23 through 29 unpatentable under 35 U.S.C. § 103(a).

2. The combination of Wugoski, Dolan, A90, and Burkett renders claim 11 unpatentable under 35 U.S.C. § 103(a).

3. The combination of Wugofski, Dolan, A90, and Eyer renders claims 14, 16, and 20 through 22 unpatentable under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner's decision rejecting claims 8 through 14, 16, and 20 through 29.

REVERSED

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